



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,421	02/26/2002	Koji Hanasaki	2002-0287A	3293

513 7590 08/06/2003

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

[REDACTED] EXAMINER

FORD, JOHN M'

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/069421	Hanasaki et al.
	Examiner	Group Art Unit
	J.M. Ford	1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ~~THREE~~ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on June 7, 2003.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

Claim(s) 1-23 and 27--34 is/are pending in the application.

Of the above claim(s) 1-7, 15-23 and 28-34 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 8--14 and 27 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

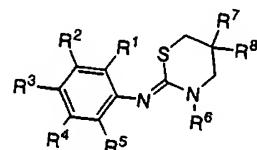
Art Unit: 1624

Applicant's response of June 4, 2003, is noted, with an election of Group I, claims 8—14 and 27.

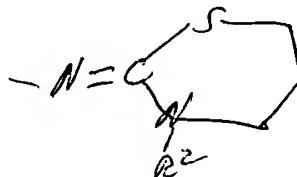
Therefore, for the present claims 1—7, 15—23 and 28—34 stand withdrawn.

However, once a compound genus is arrived at as allowable, a method and composition claim of the same scope will be added back in, if applicants wish. Claims 31 and 5 are suggested.

The election of species of the type found on page 113



is taken to mean what is elected is:



being a 6 membered ring and A is benzene, as each variation is patentably distinct.

Claim 8 is rejected under 35 U.S.C. 112, 1st paragraph. Alkyl, alone or in a combined term, is not limited from infinity, nor is aryl. Optionally substituted is found throughout the claim. Optionally substituted with what? Heteroaryl or aromatic heterocyclic stagger the mind. What is intended? A list of specific, intended, supportable heterocyclic rings is what is needed here.

Prodrug ? A unknown open chain ~~an~~ cyclized by the body to the elected thiazine? No one knows what the pro-drug would be, what compound fed to the body would produce the instant compounds? It is an entire other invention to determine what the pro-drug might be.

A solvate of what? What solvents are used to produce what solvate? What is the structure of the solvate claimed?

In claim 2, A is assumed to be benzene, re the election. Any and all carboxylic rings could not be accepted. All ~~aromatic~~ heterocyclics could not be searched. Each is completely distinct ~~from~~ the benzene of the species elected, and could not be ~~worked~~ on in the limited time provided to examine each invention. See 37 CFR 1.141 "one invention per application".

Claim 9 is rejected for the reasons claim 1 is/was. Prodrug and solvate are not seen to be allowable concepts.

Similarly in claims 10—13 prodrug and solvate are not seen to be allowable concepts, ~~as~~ they are staggering large concepts, and not supportable.

R1 is elected to be C3 alkylene necessary to form the 6 membered thiazine. ~~Thiazoles~~ and thiazepines could be examined ~~here~~^{not} and are completely independent and distinct concepts capable of supporting separate patents- 35 U.S.C. 121 provides authority to restrict the application.

Claim 14 becomes unreadable at line 5 of the claim. Instance^s where R1 is trimethylene are considered within what is elected. 1,1-dimethyl^h ethylene or 1 methyl ethylene or 1 methyl ethylene at line 5 should be removed, with the protection of 35 U.S.C. 121.

In claim 14, A being benzene is considered what is elected. The other variations are patentably distinct.

Prodrug and solvate stand rejected for the reasons claim 8 was/is.

In regard to the 1449. Dixon PCT/U.S.99/29601 is WO/00/42031. Dixon teaches the instant invention, compare, under 35 U.S.C 102/103.

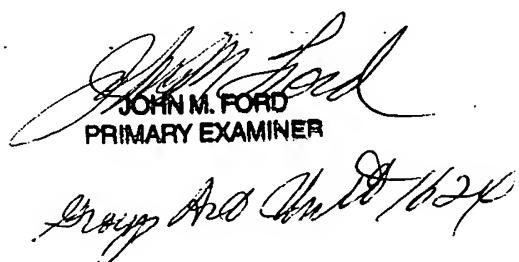
The PCT search report, indicates

an X designation (35 U.S.C. 102) for Gieldanowski et al., JP 62-212378 and JP 2-3678). Applicant's input is requested in regard to the X designation. Too numerous to mention specifically. See the PCT/ISA/210 search report.

The priority document JP-11-260780 is not found in this file. The PCT document JP00/06185 is found.

John M. Ford:jmr

August 4, 2003


JOHN M. FORD
PRIMARY EXAMINER
